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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,060	03/28/2006	Guido Schnyder	101215-216	9386
27387 7590 08/27/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
BLATT, ERIC D				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
08/27/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,060

Applicant(s)

SCHNYDER ET AL.

Examiner

Eric Blatt

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

Applicant has submitted that the Information Disclosure Statements submitted March 28, 2006 and December 21, 2006 were not properly treated by the Examiner since the listed items were not initialed. Examiner has stated on these documents, "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH." By not lining through the listed items, Examiner has indicated that these references have been fully considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanner (US 6,506,210) in view of Bolz et al. (US 6,287,332).

Regarding claims 22-41, Kanner discloses a staple (Figure 4) for urging together two or more portions of a tissue body wherein the staple is made from a bioresorbable material. Kanner does not disclose further details of the bioresorbable material.

Bolz discloses a medical member comprising a bioresorbable material which is transformable in said tissue into smaller elements such as colloidal particles. (Column

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2, Lines 45-55) Said material is a metal alloy containing a first component which covers itself with a protective oxide coat and a second component which ensures sufficient dissolution of the oxide coat. (Column 2, Lines 26-33) Said first component comprises magnesium. The corrosion products originate therefrom in the form of soluble salts, fine particles, or colloidal particles, or a mixture thereof. (Column 2, Lines 45-55) The alloy contains zinc as a corrosion-inhibiting component and calcium. The zinc/calcium weight ratio is at least 21/1. (Column 4, Lines 2) The alloy contains sodium and magnesium. The material is an alloy of zinc and titanium wherein the alloy has a weight percentage of titanium of 0.1% to 1%. (Column 4, Lines 45-55) The member comprises a support body made of a substantially pure first metal and a local electrode made of a second metal which is in contact with the support body to produce a contact voltage and a resulting current that leads to active degradation of the sealing member. (Column 3, Lines 35-52) The local electrode is a coat on the support body or, alternatively, is a metal part attached to the support body. (Column 3, Lines 52-58) The support body consists essentially of zinc, and the local electrode consists essentially of a precious metal. (Column 4, Lines 24-27) Said coat is deposited by electroplating. The member is made of a phosphorus-containing alloy. (Column 4, Lines 12-16) The alloy is hydrogen-treated. (Column 2, Lines 55-65) The alloy corrodes at such a rate that gases arising during corrosion physically dissolve in a body fluid to which the alloy is exposed. (Column 2, Lines 45-55)

Kanner discloses that the staple that "can be formed of any biocompatible and/or bioabsorbable materials." It would have been obvious to modify the apparatus of

Kanner by having the staple be made of the bioresorbable materials disclosed in Bolz since these were known bioresorbable materials and their use would not have produced unexpected results.

Response to Arguments

Applicant's arguments filed 6-04-2008 have been fully considered but they are not persuasive. Applicant submits three arguments to support a case that it would not have been obvious to one of ordinary skill in the art to make the staple of Kanner using the bioresorbable material of Bolz.

First, Applicant argues that it would not have been obvious to modify the staple of Kanner by using the claimed bioresorbable material since Kanner teaches away from such a modification. Applicant submits that Kanner discloses a staple made from bioresorbable materials having properties "that are completely opposite to the physical characteristics . . . of the material for the presently claimed member." Examiner freely admits that Kanner does not disclose all the details of the claimed bioresorbable material. That said, Kanner discloses that the staple "can be formed of any biocompatible and/or bioabsorbable materials." (Column 4, Lines 36-37) Applicant's claimed material is a bioabsorbable material. Examiner sees no reason to believe that Kanner teaches away from making the staple from a biocompatible material having the presently claimed properties.

Applicant then argues that Bolz does not remedy the deficiencies of Kanner because "Bolz fails to teach or suggest a member for urging together two or more

portions of tissue." Kanner discloses a member for urging together two or more portions of tissue that may be made from any bioabsorbable material. Bolz discloses a bioabsorbable material used for making medical devices. The obviousness of this combination does not rely on Bolz disclosing a member for urging together portions of tissue.

Finally, Applicant submits that one of ordinary skill in the art would not think to combine the staple of Kanner with the bioabsorbable material of Bolz since one of ordinary skill in the art would not be led to believe that these materials would allow scarring of an injured tissue against which it would be placed. Applicant arrives at this conclusion by noting that Bolz teaches using the bioresorbable materials disclosed therein for stents, and that it is typically desirable to minimize scarring when deploying a stent. Applicant reasons that one of ordinary skill in the art would deduce from these facts that the materials of Bolz inhibit scarring despite the fact that the disclosure of Bolz never mentions anything of the sort. This line of reasoning is clearly flawed since materials used in stents do not necessarily inhibit scarring. Assuming for the sake of argument that one of ordinary skill in the art would assume that the materials of Bolz inhibit scarring, it is unclear how this point is relevant to the obviousness of the combination cited in the standing rejection. Kanner teaches that the staple disclosed therein may be made from *any* bioabsorbable material—including those which inhibit scarring.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

Eric Blatt
571-272-9735